

REMARKS

The Examiner's attention to the present application is noted with appreciation.

The Examiner rejected claims 1 and 5 under 35 U.S.C. § 112 for lacking proper antecedent basis for terms contained therein. The claims have been amended such that all terms now have proper antecedent basis.

The Examiner rejected claims 1-18 under 35 U.S.C § 103(a) as being unpatentable over Edson, in view of prior art cited in Applicant's specification, and further in view of Cammarn et al. and still further in view of Avera, and yet still even further in view of Stockton. This rejection is traversed, particularly as to the amended claims.

Applicant has amended independent claims 1 and 14 to recite "the process not relying on hydrogenated oils to prevent oil separation; the process not relying on stabilizers to prevent oil separation; the process not relying on an emulsification process to prevent oil separation; and the nut butter or spread exhibiting very low oil separation" and it is believed that this new limitation obviates the Examiner's rejections. However, the merits of the present rejection are nonetheless addressed hereinafter.

Applicant's invention relates to a natural nut butter or spread wherein the oil does not separate due to a unique mixture and process.

In rejecting Applicant's claims, the Examiner relies on the combination of not one, not two, not three, not even four, but five different references. In so doing, the Examiner is forced to combine references which teach away not only from each other, but which also teach away from Applicant's claimed invention. Applicant's amended claims 1 and 14 recite "the process not relying on hydrogenated oils to prevent oil separation; the process not relying on stabilizers to prevent oil separation; the process not relying on an emulsification process to prevent oil separation and the nut butter or spread exhibiting very low oil separation".

Stockton, at columns 5 and 6 goes into great detail about how that invention relies on hydrogenated oils and/or other stabilization oils to prevent separation of the peanut oil from the peanut solids. Accordingly, that reference relies upon a principal problem which Applicant's invention seeks to

address and the use of hydrogenated oils and/or other stabilization oils is thus the antithesis of Applicant's claimed invention. In addition, it is important to note that the Examiner has misquoted Stockton such that an interpretation is provided by the Examiner which is the exact opposite of what Stockton obviously intended. That is to say, the Examiner asserted that "Stockton discloses that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103)". What Stockton actually discloses at the portion cited is: "[t]his difficulty of oil separation being foreseen may in only a very partial degree be prevented by coarse grinding; for the finer the grinding of the kernels the more pronounced the tendency to gravitational separation. But coarse ground peanut butter is less desirable. It is mealy and does not spread well, and furthermore it is less readily digested than fine ground butter. Another expedient that has been resorted to, to prevent in some measure this gravitational separation is to diminish the value of the fraction of oil in the mass. . .", (emphasis added). Thus not only does Stockton teach away from coarse grinding to control oil separation, but Stockton also teaches away from Applicant's claimed invention by denouncing coarse grinding and graphically describing the less than desirable results that are associated with Applicant's coarse grind.

Avera teaches away from Applicant's claimed invention and some of the other cited references by relying on the use of blanched nuts (see Avera Abstract). The additional step of blanching nuts not only significantly increases the cost and complexity of the overall process, but can also break apart some nuts and thus results in a portion of the raw materials being discarded, and thus wasted. Because Applicant's invention teaches away from the increased costs, complexity, and wastefulness associated with blanching the nuts, and because it is believed that Applicant's use of blanched nuts helps reduce residual natural oils released from grinding the nuts, Applicant's claims are directed to the use of un-blanched nuts. Avera thus teaches away from Applicant's claimed invention, which recites "introducing whole, unblanched nuts into a mill".

Cammarn et al. teach a system which relies on a stabilizer. Because Applicant's amended independent claims recite "the process not relying on stabilizers to prevent oil separation", Cammarn et al. thus teach away from Applicant's claimed invention.

With respect to Applicant's description of the prior art, which the Examiner relies on in rejecting Applicant's claims, Applicant states that known natural peanut butters which do not rely on emulsifiers or stabilizers results in a peanut butter which "exhibits gravitational instability, i.e., oil separation on the top of the product." (Paragraph 0035). Accordingly, that citation teaches away from Applicant's amended claims which recite "the nut butter or spread exhibiting very low oil separation."

The Examiner's reliance on a novel combination of minute details culled from so many different references illustrates the post-facto hindsight nature of this § 103 rejection. The Federal Circuit has already held that "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.

Because several of the prior art references cited by the Examiner teach away from each other, the Examiner's proposed modifications to them, in an attempt to result in Applicant's claimed invention, thus renders the prior art inventions being modified unsatisfactory for their intended purpose. In *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), the claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

Still further, even despite all of the foregoing, the combination of these particular references is still inappropriate. This is because the references themselves rely on entirely different processing techniques which render it theoretically and physically impossible for one of ordinary skill in the art to combine the references. For example, the non-blanching nuts of Edson, which is not a nut butter at all but rather a "candy", and Cammarn et al. (which "must comprise unblanching white-skinned peanuts", Col. 2, lines 57-58), cannot be combined with the blanching nuts of Avera to render Applicant's un-blanching nuts. It is further impossible to combine Stockton's, Avera's, and Cammarn et al.'s use of hydrogenated oils and/or stabilizers with known natural nut butters, which do not use hydrogenated oils or stabilizers and which thus exhibit a large amount of oil separation, to result in Applicant's claimed invention which does not use hydrogenated oils and/or stabilizers to achieve a nut butter which exhibits a low amount of oil separation. Accordingly, the Examiner's inappropriate combination of specific inventive attributes, which have been precisely culled from each of the numerous prior art references, thus changes principle of operation of the prior art inventions being modified and such a combination cannot properly be relied on in rejecting Applicant's claimed invention (see *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). In that matter, the claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.

Because the inventive concepts of Applicant's claimed invention have been selectively culled from the numerous prior art references by the Examiner in a post facto manner; and because the prior art references teach away from Applicant's invention, and because the prior art references teach away from each other; and because forcing the combination of the numerous cited references results in substantial


reconstruction and/or redesign of the elements of those inventions; and because one skilled in the art would not attempt to so combine the details of the numerous references in such a novel and non-obvious manner; and because the Examiner's combination of the numerous prior art references renders them unsatisfactory for their intended purpose, the novel combination of the prior art references cited by the Examiner is thus inappropriate in rejecting Applicant's amended claims.

In view of the above amendments and remarks, it is respectfully submitted that all grounds of rejection and objection have been avoided and/or traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

The fee for additional claims is included. Also being filed herewith is a Petition for Extension of Time to June 9, 2007, with the appropriate fee. Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

Respectfully submitted,

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